

## **REMARKS**

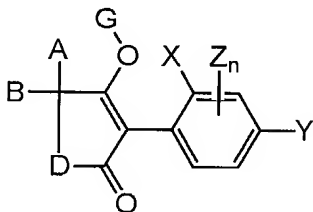
Applicants gratefully acknowledge the indication that Claims 5 and 17-23 would be allowable if written in proper independent form and that Claims 6-11 are allowed.

For the reasons discussed below, Applicants respectfully submit that the remaining claims should also be allowed. Consequently, Applicants have not placed Claims 5 and 17-23 in independent form.

### **Rejection under 35 U.S.C. 103**

Claims 1-4, 12, 14, and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art represented by certain teachings of EP 528,156 (which corresponds to U.S. Patent 5,262,383). Applicants respectfully traverse.

EP 528,156 discloses insecticidally, acaricidally, herbicidally, and fungicidally active 3-aryl-4-hydroxy- $\Delta^3$ -dihydrofuranones having a very broadly defined scope within the general formula



in which the various substituents are defined as shown in the U.S. '383 counterpart at columns 1-2 and elsewhere. Among the multitude of compounds disclosed in the European application are those in which A and B together represent a spiro cycle that is optionally substituted. Among the many possible disclosed substituents for such spiro moieties are halogenoalkyl groups such as the trifluoromethyl group. E.g., U.S. '383 at column 10, lines 26-32, column 12, lines 7-14, and column 13, lines 61-69. The cited patent, however, does not provide biological data for compounds having such trifluoromethyl substitution and does not suggest that compounds having trifluoromethyl substitution would exhibit significantly different properties from any other disclosed compound.

It has long been recognized that even structurally similar inventions can be patentably distinct under certain circumstances. E.g., *U.S. v. Adams*, 383 U.S. 39, 148 U.S.P.Q. 479 (1966). For example, a narrowly claimed invention is not rendered obvious merely because a reference discloses "compounds having a generic formula

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which would include [the claimed compounds] if proper selection from among the many possible variables were made as suitable for the claimed purpose," particularly where "the shotgun type approach of the reference . . . would not guide one skilled in the art to choose [applicants'] restricted class of compounds from among the host of possible combinations and permutations suggested by patentees." *Ex parte Strobel and Catino*, 160 U.S.P.Q. 352 (P.O. Bd. App. 1968); see also *In re Baird*, 29 U.S.P.Q.2d 1550, 1552 (Fed. Cir. 1994). Applicants respectfully submit that they have presented comparative test data consistent with the patentability of their claimed compounds.

Although Applicants have not compared compounds within their claims with compounds that are specifically disclosed in EP 528,156, they have compared compounds of their invention with known compounds that differ only in having methyl-substituted cyclohexyl spiro groups instead of trifluoromethyl-substituted cyclohexyl spiro groups. In particular, Applicants' Table A (pages 106-107), Table B (page 109), Table C (page 111), Table D (page 113), Table E (page 115), and Table F (page 117) report data obtained by directly comparing various compounds of Applicants' invention with compounds disclosed in EP 596,298 (which is a counterpart of U.S. Patent 5,462,913 and its divisional U.S. Patent 5,677,449), WO 98/05638, WO 97/01535 (which is a counterpart of U.S. Patent 6,110,872 and its divisional U.S. Patent 6,511,942), and WO 97/36868. [Applicants' tables label the comparison compounds with the numbers from the appropriate reference.] In every case, Applicants' trifluoromethyl-substituted compounds exhibit significantly greater activity than the corresponding methyl-substituted compounds of the prior art.

In view of this clear demonstration of enhanced activity, Applicants submit that their trifluoromethyl-substituted compounds are patentably distinct from those disclosed generically in EP 528,156. Applicants therefore respectfully submit that their Claims 1-4, 12, 14, and 15 are not rendered obvious by EP 528,156.

In view of the preceding remarks, allowance of the claims is respectfully requested.

Respectfully submitted,

By Richard E. L. Henderson  
Richard E. L. Henderson  
Attorney for Applicants  
Reg. No. 31,619

Bayer CropScience LP  
100 Bayer Road  
Pittsburgh, Pennsylvania 15205-9741  
PHONE: (412) 777-3809  
FACSIMILE PHONE NUMBER:  
412-777-3902  
s/rmc/rejh/0275